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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,620	03/08/2007	Alan P. Kozikowski	GUX-010.01	4324

25181 7590 02/25/2011
FOLEY HOAG, LLP
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BOSTON, MA 02110

EXAMINER

CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

NOTIFICATION DATE	DELIVERY MODE
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02/25/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent@foleyhoag.com

Office Action Summary	Application No. 10/576,620	Applicant(s) KOZIKOWSKI ET AL.	
	Examiner Celia Chang	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,24-56 and 108-118 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-4,24-29,32,35-40,43,46-51,54,108-113 and 116 is/are rejected.
- 7) ☐ Claim(s) 30,31,33,34,41,42,44,45,52,55,56,114,115,117 and 118 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

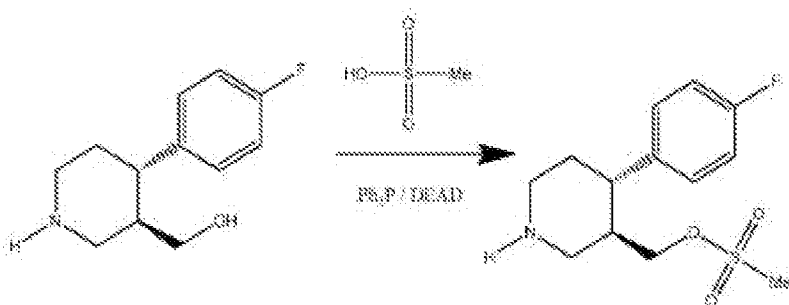
1. Amendment and response filed by applicants dated Dec. 16, 2010 have been entered and considered carefully.

Claims 5-23, 57-107 have been canceled.

Claims 1-4, 24-56, newly added 108-118 are pending.

2. The rejection of claims 27-29, 32-34, 38-40, 43-45, 49-51, 54-56 under 35 U.S.C. 112 second paragraph for the limitation "halophenyl" or "3-chlorophenyl" for moiety R3 lacking sufficient antecedent basis in the base claim is maintained. Even though applicants can be his own lexicographer aryl without substitution cannot encompass halophenyl. Please note that the description for aryl did not include substituted phenyl.

3. The rejection of claims 1-4, 27-28, 35 under 35 U.S.C. 102(b) as being clearly anticipated by Jones et al. CA134:100766 is dropped in view of applicants presentation that reaction of example 6 would produce



which is not the structure as delineated by CAS since applicants presented that the product through synthetic process of the reference does not match the chemical name.

4. The rejection of claims 25-26, 36-39, 47-50 under 35 U.S.C. 103(a) as being unpatentable over WO01/004093 (recited on 1449) is dropped in view of the above presentation by applicants for lacking anticipation, thus, no obviousness.

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5. The rejection of claims 1-4, 24-56 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 7,517,892 is corrected to a rejection under 35 U.S.C. 103(a) by applicants assertion that the case and the instant case were not commonly owned or assigned or subject to joint research agreement.

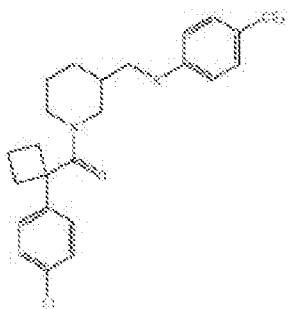
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 24-29, 32, 35-40, 43, 46-51, 54, 108-113, 116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aquila et al. US 7,517,892 (cited on 892 dated 7/16/10).

Please note that US 7,517,892 qualified as a 102(e) date reference because the effective filing date is Sept. 11, 2000 wherein the generic description supported by examples 41-42 were disclosed.

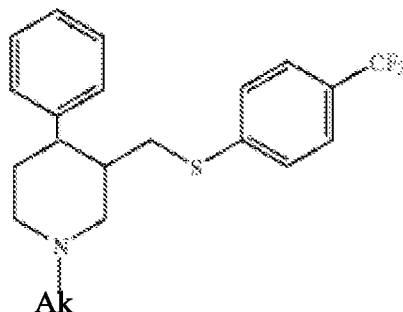
Aquila et al. '892 disclosed examples 41-42 which has the structure:



The exemplified species corresponding to the generic disclosure when R3 is H, R4 is cycloalkyl, R5, R6 forms a CO (see col. 12-13 formula A)

Generically, the R3 moiety is optionally aryl (col. 13, lines 6-7), and R4, R5, R6 can all be H or alkyl (coll. 13, lines 10-15). Therefore, based on the alternative optional of the Markush elements, the above species is tantamount to the compound:

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which is the instantly claimed compounds. The picking and choosing of alternative choices among many is prima facie obvious in absence of unexpected results. In re Lemin 141 USPQ 814.

6. Claims 30-31, 33-34, 41-42, 44-45, 52, 55-56, 114-115, 117-118 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The subject matter wherein R₄ is CON(R⁶)₂ is not anticipated nor rendered obvious by the art of record.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang, Ph. D. whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres, Ph. D., can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Feb. 14, 2011

/Celia Chang/
Primary Examiner
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